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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/482,283	06/07/1995	ROBERT C. THOMPSON	04189.0083-0	2193

22852 7590 05/16/2002

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1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

SPECTOR, LORRAINE

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 05/16/2002

37

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 12/12/01, 3/1/02, 3/5/02

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1, 17-25, 37-138 is/are pending in the application.
Of the above, claim(s) 1, 17-21 is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 22-25, 37-138 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☒ Claim(s) 1, 17-25, 37-138 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☒ The specification is objected to by the Examiner.
☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 31, 36
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

Part III: Detailed Office Action

Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's first submission after final filed on 12/2/01 has been entered.

Amendments to the claims were made in papers numbered 33-35, submitted on 12/12/01, 3/1/02 and 3/5/02, respectively. It is noted that claim 42 was added by amendment in paper number 34, and that paper number 35 again introduced a "new" claim 42. While normally the second "new" claim 42 would have been renumbered (as would all successive claims) under 37 C.F.R. § 1.126, it seems clear in this case that the second "new" claim 42 is intended actually to be an amendment to claim 42, and it has been treated as such.

Claims 22-25 and 37-138 are under consideration.

Formal Matters:

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claims 55 and 96 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Drawings:

The drawings remain objected to as failing to comply with 37 C.F.R. § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In Figure 6 and Figure 7, the chromatographic peaks are given number 1-18 and 1-7, respectively, but these reference

numbers are not mentioned in the description. Correction is required.

The drawings remain objected to because in Figure 4A, the text is upside down. Correction is required.

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Figures 4, 13, and 15 of the instant application are presented on multiple separate panels. 37 C.F.R. § 1.84 (u)(1) states that when partial views of a drawing which are intended to form one complete view, whether contained on one or several sheets, must be identified by the same number followed by a capital letter. Applicant is reminded that once the drawings are changed to meet the separate numbering requirement of 37 C.F.R. § 1.84 (u)(1), Applicant is required to change the Brief Description of the Drawings and the rest of the specification accordingly (see p. 42, line 20; p. 17, line 8; p. 18, line 17; and p. 18, line 24). If, for example, Figure 4 is divided into Figures 4A and 4B, then the Brief Description and all references to this figure in the specification must refer to Figures 4A and/or 4B. While all drawings except are correctly numbered, *e.g.*, Figure 4A, Figure 4B, the description of the drawings does not correspond.

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Oath/Declaration:

The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

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The oath or declaration is defective because:

Non-initialed alterations have been made to the oath or declaration. See 37 C.F.R. § 1.52(c) and 1.57).

The Residence and Country of Citizenship of inventor R.C. Thompson have been altered without initialing.

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Double Patenting Rejections:

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

Claims 22-25 and 37-40 remain, and newly introduced claims 41-138 are rejected under the judicially created doctrine of double patenting over the claims of prior U.S. Patent No. 5,075,222, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent for reasons cited in the previous Office Action, mailed 1/30/98 , at page(s) 4-5.

Applicants intent to file a terminal disclaimer to overcome this rejection is noted.

Rejections under 35 U.S.C. § 112:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38, 41-53, 98-104, 106, 116-122, 124, 137 and 138 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 38 and 41 are indefinite because the Examiner cannot discern any difference in the scope of coverage afforded by the two claims. As applicants clearly intend there to be a difference, the claims are indefinite. Claims 98 and 106, are similarly indefinite, as are claims 116 and 124 .

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Art Unit 1647

All remaining rejected claims are indefinite for depending from an indefinite claim.

Advisory Information:

No claim is allowed.

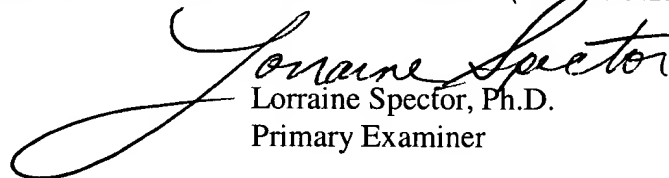
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector, whose telephone number is (703) 308-1793. Dr. Spector can normally be reached Monday through Friday, 9:00 A.M. to 5:30 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary L. Kunz, at (703)308-4623.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

Certain papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Official papers filed by fax should be directed to (703) 872-9306 (before final rejection) or (703)872-9307 (after final). Faxed draft or informal communications with the examiner should be directed to (703) 746-5228.


Lorraine Spector, Ph.D.
Primary Examiner

LMS
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5/14/02